

REMARKS

Claims 1-7 are now pending in this application. Claims 1, 3, and 4 are rejected. Claim 2 is objected to. New claims 5-7 are added. Claims 1-4 are amended herein to place them in better form. Also, some of the limitations of claim 2 have been added to claim 1. The specification has been amended to place it in better form.

Claims 1 and 4 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Publication 2002/0067800 (Newman et al.). Some of the limitations of allowable claim 2 have been incorporated into claim 1 to secure its allowance. For example, claim 1 now recites the sample detecting device comprising a specific macromolecule detecting means for irradiating ultraviolet light on the sample container and detecting a fluorescent image emitted from the sample in the sample container and also recites the control means being configured to identify a specific macromolecule based on the fluorescent image detected by the specific macromolecule detecting means. Such limitation is not disclosed in Newman et al. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Brothers Inc. v. Union Oil Company of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Accordingly, claim 1 is patentable over Newman et al. and notice to that effect is respectfully requested. Claim 4 is patentable at least for the reason that it

depends from a patentable base claim. *See In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974).

Claim 3 has been rejected under 35 U.S.C. § 103(a) as obvious over Newman et al. in view of U.S. Patent 4,964,150 (Van Der AA et al.). Some of the limitations of allowable claim 2 have been incorporated into claim 1 to secure its allowance. For example, claim 1 now recites the sample detecting device comprising a specific macromolecule detecting means for irradiating ultraviolet light on the sample container and detecting a fluorescent image emitted from the sample in the sample container and also recites the control means being configured to identify a specific macromolecule based on the fluorescent image detected by the specific macromolecule detecting means. Such limitation is not disclosed or suggested in Newman et al. in view of Van Der AA et al. To establish a *prima facie* case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974). Accordingly, claim 1 is patentable over Newman et al. in view of Van Der AA et al. and notice to that effect is respectfully requested. Claim 3 is patentable at least for the reason that it depends from a patentable base claim. *See In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

Claim 2 has been objected as dependent from a rejected base claim but has been deemed allowable. Claim 1 has been amended to be allowable and

Applicants therefore respectfully request that the objection of claim 2 be withdrawn and that claim 2 be allowed.

New claims 5-7 have been added and claims 1-4 have been amended to be in better form. Support for the amendments to claims 1-4 and for new claims 5-7 is found, for example, in the claims as filed and in Figure 5 .

Claims 5-7 are believed patentable for substantially for the same reasons as claims 2-4.

The present invention is directed, *inter alia*, to distinguish protein crystals from, for example, small molecule crystals. The small molecule crystals may be present since chemicals used as precipitants of protein crystallization are often small molecules. Small molecule crystals do not generally emit fluorescence and therefore it is extremely useful to use ultraviolet radiation to distinguish between protein crystals and small molecule crystals to eliminate small molecule crystals from x-ray irradiation to improve efficiency in crystal screening. Visible light also helps in the analysis, as described in the specification. None of the cited art discloses or suggests the above-mentioned way to distinguish protein crystals. Accordingly, claims 1-7 are believed to distinguish over the cited art and Applicants respectfully request that claims 1-7 be allowed.

Applicants respectfully request a two month extension of time for responding to the Office Action. **The fee of \$450.00 for the extension is**

**provided for in the charge authorization presented in the PTO Form 2038,
Credit Card Payment form, provided herewith.**

If there is any discrepancy between the fee(s) due and the fee payment authorized in the Credit Card Payment Form PTO-2038 or the Form PTO-2038 is missing or fee payment via the Form PTO-2038 cannot be processed, the USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg
C. Bruce Hamburg
Reg. No. 22,389
Attorney for Applicants

BV and,

By Ricardo Unikel
Ricardo Unikel
Reg. No. 52,309
Attorney for Applicants

Jordan and Hamburg LLP
122 East 42nd Street
New York, New York 10168
(212) 986-2340

enc: Form PTO-2038